Remarks/Arguments:

Claims 1-16 are pending in the above-identified application. Claims 1-2, 7 and 14 have been amended. Accordingly, claims 1-16 are presented for reconsideration.

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the Examiner is unsure as to what "VG" refers to when describing an oil grade. A "person of ordinary skill in the art" would understand that "VG" refers to the viscosity grading system established by the International Standards Organization (ISO). Claim 1, however, has been amended to recite "ISO VG3" and "ISO VG8" to make clear that the "VG" refers to the viscosity grading system established by the ISO. Withdraw of the rejection is respectfully requested.

Claim 2 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the Examiner is interpreting claim 2 to mean that "more oil boils at the lower temperature." (Office Action, page 2, lines 12-14). Claim 2 has been amended to clarify that the first and second characteristics of the oil, and not the oil itself, have different boiling points. Withdraw of the rejection is respectfully requested.

Claims 7 and 14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Accordingly, Applicants have amended these claims to be more clear. Withdraw of the rejection is respectfully requested.

Claims 1-3, 5 and 12 were rejected under 35 U.S.C. § 103 (a) as being obvious over Kwon et al. Claim 1 is amended to recite features neither disclosed nor suggested by the prior art, namely:

> ... wherein the **oil ranges from** a viscosity grade not lower than **ISO VG3 to** a viscosity grade not higher than **ISO VG8**. (Emphasis added).

Applicants have determined that oil in the range of ISO VG3 to ISO VG8, as recited in claim 1, produces a desired friction coefficient. (FIG. 3).

The Examiner argues that the oil in Kwon et al. is within the viscosity range recited in claim 1. (Office Action, page 4, lines 6-11). Kwon et al., however, does not

disclose oil ranging "... from a viscosity grade not lower than ISO VG3 to a viscosity grade not higher than ISO VG8." Rather, Kwon et al. does disclose the oil has a viscosity index from 73-99. (Col. 3, lines 38-40).

"ISO VG3" and "ISO VG8" are grades according to the viscosity grading system established by the ISO. The ISO defines the viscosity level using grade values (i.e. VG3, VG8) to indicate a kinetic viscosity level of the lubrication oil at 40 degrees Celcius. By contrast, viscosity index (VI), as disclosed in Kwon et al., indicates a variation of the kinetic viscosity level of the lubrication oil with temperature. That is, the viscosity grade and viscosity index have no relation to each other and are different in terminology and usage. It is, therefore, not possible to obtain the viscosity grade from the viscosity index. Accordingly, a person of ordinary skill in the art would not be able to determine Applicants' claimed viscosity range of ISO VG3 to ISO VG8 from the viscosity index disclosed in Kwon et al.

Thus, Applicants respectfully submit that claim 1 is allowable over the art of record. Claims 2-3, 5 and 12 ultimately depend from claim 1. Accordingly, claims 2-3, 5 and 12 are likewise allowable over the art of record. Claim 2 include patentable features in addition to the features of claim 1, namely,

> ... the oil includes at least one of a first characteristic having a boiling point at 350°C or over which is not less than 10% and not higher than 30% in volume ratio, and a second characteristic having a boiling point at 300°C or less which is not less than 50% and not higher than 70% in volume ratio.

Applicants have determined that oil produces desired results (i.e. no sludge) when the first component is "... not less than 10% and not higher than 30% in volume ratio ..." and the second component is "... not less than 50% and not higher than 70% in volume ratio," as recited in claim 2. Kwon et al. generally describes physical characteristics (i.e. thermally and chemically stable, sludge, friction) of the oil. (Col. 2, lines 15-23). However, Kwon et al. does not disclose the specific volume ratios of the first and second components in claim 2. Thus, Applicants respectfully submit that claim 2 is allowable over the art of record for features in addition to the features recited in claim 1.

Claims 4 and 11 were rejected under 35 U.S.C. § 103 (a) as being obvious over the combination of Kwon et al. and Seiki. Seiki does not make up for the deficiencies of Kwon et al., as described above with respect to claim 1. Claims 4 and 11 depend from claim 1. Accordingly, claims 4 and 11 are also allowable because they depend from allowable claim 1.

Claims 6-7 and 13-14 were rejected under 35 U.S.C. § 103 (a) as being obvious over the combination of Kwon et al. and Nagai et al. Nagai et al. does not make up for the deficiencies of Kwon et al., as described above with respect to claim 1. Claims 6-7 and 13-14 depend from claim 1. Accordingly, claims 6-7 and 13-14 are allowable because they depend from allowable claim 1.

Claims 8 and 15 were rejected under 35 U.S.C. § 103 (a) as being obvious over the combination of Kwon et al., Nagai et al. and Hannibal. Hannibal does not make up for the deficiencies of Kwon et al. and Nagai et al., as described above with respect to claim 1. Claims 8 and 15 depend from claim 1. Accordingly, claims 8 and 15 are allowable because they depend from allowable claim 1.

Claims 9 and 16 were rejected under 35 U.S.C. § 103 (a) as being obvious over Kwon et al., Nagai et al. and Kojima et al. Kojima et al. does not make up for the deficiencies of Kwon et al. and Nagai et al., as described above with respect to claim 1. Claims 9 and 16 depend from claim 1. Accordingly, claims 9 and 16 are allowable because they depend from allowable claim 1.

In view of the foregoing amendments and remarks, Applicants submit that this Application is in condition for allowance which action is respectfully requested.

Respectfully submitted,

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